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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,475	06/23/2006	Manabu Sutoh	71,051-036	1993
27305 7590 05/16/2008 HOWARD & HOWARD ATTORNEYS, P.C. THE PINEHURST OFFICE CENTER, SUITE #101 39400 WOODWARD AVENUE BLOOMFIELD HILLS, MI 48304-5151				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
05/16/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/584,475

**Applicant(s)**

SUTOH ET AL.

**Examiner**

Victor S. Chang

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-9, 12, 15, 16 and 19 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 12, 15, 16 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Paper No(s)/Mail Date \_\_\_\_\_
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. Applicants' amendments and remarks filed on 3/27/2008 have been entered. Claims 1, 5, 15, 16 and 19 have been amended. Claims 2, 10, 11, 13, 14, 17, 18 and 20 have been cancelled. Claims 1, 3-5, 12, 15, 16 and 19 are active.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

### ***Rejections Based on Prior Art***

4. Claims 1, 3-5, 12, 15, 16 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 571 649.

EP '649 relates to a dicing-die bonding film for producing semiconductor chips [abstract]. A Figure illustrates that the bonding film comprises in sequence a substrate (base film) 1, a pressure-sensitive layer 2, a first adhesive layer 3, and a second adhesive layer 4 [col. 3, ll. 12-16]. The second adhesive layer can be formed by semi-curing a thermosetting silicone resin to B-stage [col. 6, ll. 47-55]. A semiconductor wafer is placed on and bonded with the second adhesive layer of the film to fix the wafer. The resulting wafer is cut into chips by suitable means such as a rotary wheel cutter. The dicing-die bonding film has a sufficient holding power during cutting thereof into chips and the cut chips can be smoothly peeled along

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with the first and second adhesive layers due to the good release properties of the first adhesive layer to the pressure-sensitive layer. The second adhesive layer side (outer surface) is temporarily covered with a separator (strippable layer) to protect the layer [col. 7, ll. 24-57].

For claim 1, the term “can be” is interpreted as optional limitation, and there is no requirement for the prior art to provide or account for the limitation, because it does not constitute a limitation in any patentable sense.

For claims 3-5, 12, 15, 16 and 19, the pressure-sensitive layer and the first adhesive layer together read on the two-layer laminated undercoat. Further, since the film holds the chips cut from the semiconductor wafer, its base film has a surface area greater the wafer. Finally, since the chip is bonded to the second adhesive layer, the strippable layer is necessarily removed prior to bonding.

EP ‘649 anticipates all the features of the claimed invention.

### *Response to Arguments*

5. Applicants argue at Remarks page 7 that

“Because the EP ‘649 application requires that **both** the first adhesive layer **and** the second adhesive layer remain with the semiconductor wafer after cutting and after stripping the pressure-sensitive layer and the substrate from the wafer, EP ‘649 does not teach each and every element of the instant independent claim 1 as amended and, therefore, cannot anticipate independent claim 1 as amended.”

However, since the point of issue is recited as “can be”, it is interpreted as optional limitation, and there is no requirement for the prior art to provide or account for the limitation, because it does not constitute a limitation in any patentable sense.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794